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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/662,263 | 09/15/2003 | Patrick H. Hayes | 81230.38US4 | 9025 |
| 34018 | 7590 | 10/11/2005 | EXAMINER | |
| GREENBERG TRAUIG, LLP 77 WEST WACKER DRIVE SUITE 2500 CHICAGO, IL 60601-1732 | | | ZIMMERMAN, BRIAN A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2635 | |

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/662,263

Applicant(s)

HAYES ET AL.

Examiner

Brian A. Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

EXAMINER'S RESPONSE

Status of Application

In response to the applicant's amendment received on 8/4/05. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 1-11,14-19 remain unpatentable for the reasons set forth in this office action:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 17-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Support could not be found for storing on the media, the actual credit amount. The applicant has failed to comply with MPEP 2163 which states that the applicant should specifically point to support for any newly claimed limitation.

Claim Rejections - 35 USC § 103

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2. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pariente (WO 9409570) and Renner (5679945).

Pariente teaches a remote controller 1 that includes a readable media storage device 11 (chip-card) on which a microcircuit 12 is contained. Parameter codes defining or describing different electronic devices (the codes being stored on the chip card in memory which is inherently non-volatile) are read by the remote controller under the control of the microprocessor 15, internal to the remote controller 1, thereby programming the remote controller (abstract). Card 11 is inserted into slot 10. The card is removable and inherently includes electrical contacts in order for the remote controller to accept electrically transferable codes or commands.

The card programs the remote controller 1. The remote controller 1 accordingly now stores the codes/commands, the card is removed and the remote controller accesses internal memory EEPROM 18 to retrieve the codes/commands for operating a first (and subsequent different) electronic equipment.

In an analogous art, Renner teaches an intelligent card reader. In order to prevent unauthorized use of the smart card the card is programmed with limitations such as the number of times the card can be used or having a preprogrammed expiration date. See col. 11 lines 30-35 that specifically states that the ICR (card) can be programmed to make access based on other parameters. This is interpreted that on the card is stored (programmed) parameters that can limit access. Limiting access is interpreted as a form of

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limiting use of the code data as claimed. When the card is limited by the number of times it can be used to operate the regulated feature, the code data from the card is only read a number of times. The claims do not specify that all the data is not read or data is prevented from being read. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have used an operation limitation to the number of times the Parienti card can be used in order to prevent unauthorized use of the card to protect against unauthorized use.

3. Claims 11,14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pariente (WO 9409570) and Ishikawa (5315392).

Pariente is discussed above; such discussion is incorporated here also. Additionally, Pariente teaches the code data being representative of a channel line-up for a broadcast service provider, see page 6 lines 5-18. In an analogous art, Ishikawa teaches a remote control for a television. Ishikawa teaches a direct channel access button for accessing a specific channel in a line-up. This provides added convenience to the user/operator. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a direct channel access button in the Pariente remote controller since such would provides added convenience to the user/operator.

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pariente and Ishikawa as applied to claims 11,14 and 15 above, and further in view of Renner.

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The limitations of claim 16 mirror the limitations of claim 1 and are rejected using the same explanation of the references offered above.

5. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pariente (WO 9409570) and Krisbergh (5138649).

Pariente is discussed above; such discussion is incorporated here also. In an analogous art, Krisbergh teaches a remote control device. With regards to figure 2 Krisbergh states:

the remote control/telephone unit 10 is easily used for ordering pay-per-view services from the cable system.....In one embodiment, converter/descrambler 40 is preauthorized with a certain number of credits for receiving pay-per-view programs. If a subscriber's credit limit has not been depleted, the pay-per-view program will be immediately available for viewing. Microprocessor 48 will subsequently pass data to the cable system operator for billing purposes using data path 58 and telephone base station 42 to initiate a call to the headend for reporting of the information. In another embodiment, a telephone communication with the headend is established by microprocessor 48 via telephone base station 42 to request pay-per-view authorization upon receipt of a pay-per-view ordering signal from the remote control/telephone unit 10.

Therefore, Krisbergh teaches the use of the remote controller 10 for authorization of credit information to provide easy access to pay-per-view programs.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included credit information on the Pariente remote controller as suggested by Krisbergh since such would provide easy access to pay-per-view programs.

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6. Claim 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Pariente (WO 9409570) and Ishikawa (5315392) as applied to claims 11 and 14 above, and further in view of Krisbergh (5138649).

The limitations of claim 17 mirror the limitations of claim 18 and are rejected using the same explanation of the references offered above.

Response to Arguments

Applicant's arguments filed 4/19/05 have been fully considered but they are not persuasive.

The applicant argues that Renner does not teach that his smart card has stored thereon data that is modifiable for the purpose of limiting use of data stored on his smart card. . Renner teaches an intelligent card reader. In order to prevent unauthorized use of the smart card the card is programmed with limitations such as the number of times the card can be used or having a preprogrammed expiration date. See col. 11 lines 30-35 that specifically states that the ICR (card) can be programmed to make access based on other parameters. This is interpreted that on the card is stored (programmed) parameters that can limit access. Limiting access is interpreted as a form of limiting use of the code data as claimed (last line of claim 1). When the card is limited by the number of times it can be used to operate the regulated feature,

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the code data from the card is only read a number of times. The claims do not specify that all the data is not read or data is prevented from being read.

In response to applicant's argument that there is no suggestion to combine the Pariente and Renner references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used an operation limitation to the number of times the Parienti card can be used in order to prevent unauthorized use of the card to protect against unauthorized use.

The applicant argues that Ishikawa does not teach storing code data on a readable media where the code data enables the remote control access to a channel line up for a broadcast provider. . Pariente (page 6 lines 5-18) and Ichikawa (figure 3) teaches storing channel numbers for tuning, those channel numbers enable the remote controller to access each channel offered by the broadcast provider which is the line-up of the broadcast provider.

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The applicant argues that Ishikawa does not teach in response to activation of a direct channel access button of the remote control to read code data from the media, to cause the issuance of a command to tune an appliance to a specific channel in the channel line up of the broadcast provider. . First it is noted that the claims do not require that reading of the data from the media be in response to a key input. The combination of Ishikawa and Pariente would provide a code transmitted in response to the operation of a key (see Ishikawa) that transmits a signal learned from a code programming card as taught by Pariente. . Ishikawa teaches access to limited access programming, for example see figure 3 where there is a button provided to access HBO which is generally an additionally charge in the broadcast service provider's line-up and thus considered limited access programming.

In response to applicant's argument that there is no suggestion to combine the Pariente and Ishikawa references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a direct

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channel access button in the Pariente remote controller since such would provides added convenience to the user/operator.

The applicant argues that Krisbergh does not teach storing a credit amount on a readable media. Pariente is cited for teaching the storage of operational characteristics on a media that is used to program a remote control to provide a person's operational characteristics to the remote control ie. how the person desires the controller to operate and the functions available to that person. Krisbergh is cited to teach that one operational characteristic that is used to provide operational functions to the user is a credit amount. As the applicant points out this credit amount is stored on a cable converter and not in the remote controller. However, Krisbergh's teaching of a personalized credit amount being stored (in the home) for providing pay per view functions is advantages in that user does not need to type in credit card info each time. Providing operational characteristics in a storage media to program a remote control is taught by Pariente to reduce the programming steps when it comes to providing operational characteristics to the system.

In response to applicant's argument that there is no suggestion to combine the Pariente and Krisbergh references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in

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the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included credit information on the Pariente remote controller as suggested by Krisbergh since such would provide easy access to pay-per-view programs.

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

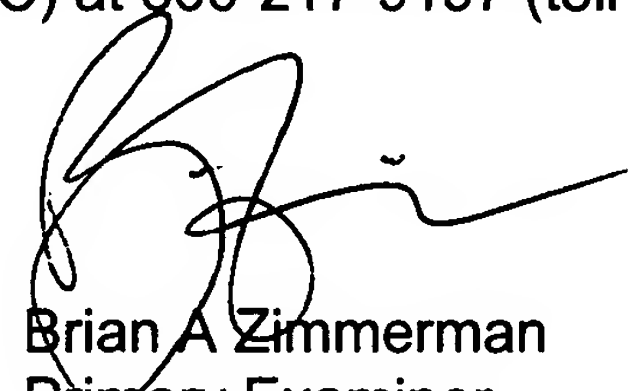
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A. Zimmerman whose telephone

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number is 571-272-3059. The examiner can normally be reached on Off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Horabik can be reached on 571-272-3068. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brian A Zimmerman
Primary Examiner
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BAZ